

## REMARKS

The Examiner, in the outstanding Office Action, has raised concerns regarding claim 1 and the phrase “less than about”, and alleges that the phrase renders claim 1 indefinite. The Examiner has further cited the U.S. patents 5,991,637 (Mack, II et al.) and 6,252,970 (Poon) and has asserted certain outstanding claims are unpatentable over Mack, II et al. in view of Poon. Furthermore, the Examiner has cited Mack, II et al. and Poon, further in view of U.S. patent 4,882,745 (Silver), as allegedly making unpatentable certain claims. Additionally, the Examiner cites Mack, II et al., Poon, and Silver, further in view of U.S. patent number 5,930,719 (Babitch et al.) as allegedly making unpatentable certain claims.

The present Amendment and Request for Reconsideration is provided to fully address the issues identified by the Examiner. It is believed that this Amendment and Request for Reconsideration is fully responsive in light of the present prosecution status of the application and accordingly is a bona fide attempt to advance the prosecution of the application.

### **Amendments to the Claims**

The Examiner is respectfully directed to claims 35 and 58 as the currently amended claims. Claim 58 is amended to remove the typographic error introduced by the inclusion of two periods at the end of the claim sentence. Claim 35, moreover, is amended to correct the typographical error introduced by the incomplete presentation of the word “wherein.” It is presently asserted that the original disclosure of the application fully supports the use of the claim term “wherein.”

### **Concerning Claim 1 Under 35 U.S.C. Section 112, 2<sup>nd</sup> Paragraph**

The Examiner asserts that the phrase “less than about” is not defined by claim 1, the specification does not provide a standard to ascertain the requisite degree, and one of ordinary skill in the art would not be apprised of the scope of the invention. The Examiner is first directed to claim 1,

as originally filed, with respectful notice that the claim does not include recitation of “less than about.” Should the Examiner maintaining a different reading of claim 1 and wish to maintain the rejection, the undersigned attorney for the assignee respectfully requests the Examiner to contact him to discuss the status of claim 1.

However, in the interest of fully addressing any concerns of the Office, the examiner is directed to claim 34, which recites “wherein said cordless telephone headset system weighs less than about 7 ounces.” It is presently urged that the phrase “less than about” is sufficiently definite as disclosed in the specification and under the requirements of 35 U.S.C. section 112, 2<sup>nd</sup> paragraph.

As the Examiner has astutely pointed out, MPEP section 2173.05(b) provides direction for ascertaining certain claim terminology under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. As cited within that section, Courts have determined that the fact that claim language, including terms of degree, may not be precise does not automatically render the claim indefinite under the statute. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984). Furthermore, and as the MPEP points out in the cited section, a determination is to be made as to whether the specification provides some standard for measuring that degree.

As but one example, citation is made to the written description of the application at paragraphs 33 and 34, wherein features of one embodiment of the invention are described wherein the base comprises a number of features, and wherein the headset is comparably lightweight with respect to previous headsets, weighing less than seven ounces, and comprising in some embodiments the various features described in paragraph 34. Each of these features are known to one of ordinary skill in the art, and the inclusion of one or more features in the headset, in some embodiments, provides a standard by which one skilled in the art can ascertain the claimed limitation of “less than about seven ounces.”

Case law, as cited in the MPEP, further supports the use of the term “about”. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); *see, also, Ex Parte Eastwood*, 163

USPQ 316 (Bd. App. 1968). It would appear that were a ascertainable degree or comparison can be made for determining claimed recitation, the language is definite. In the present application, the embodiments of the invention provide for features that may comprise the headset system, such the the weight can be determined to be less than seven ounces.

Should the Examiner have any outstanding concerns regarding the use of the claim language "less than about", the undersigned representative respectfully requests the examiner to notify him of an appropriate opportunity to further discuss the claim recitation in telephone interview.

#### **Prior Art Issues**

The Examiner has alleged that certain claims are made obvious by the Mach, II et al. patent reference in light of the above-cited references and notice taken by the Examiner. It is presently asserted that the claims are novel and nonobviousness in light of the art of record, and accordingly the outstanding rejections based upon such references should be withdrawn.

As the Examiner is aware, the burden of the Examiner in establishing a *prima facie* case of obviousness includes establishing that all claim limitations are taught or suggested by the prior art. In re Royka, 490 F.2d 981 (C.C.P.A. 1974). It is urged that the cited references do not teach or disclose the invention as claimed in claims 1, 35, 37, and 63, and the dependent claims thereof.

The Examiner has identified that Mack does not teach the telephone control pivotally connected to one of the distal ends of the headband. *See* outstanding Office Action, Paper No. 10, p. 3. As cited by the Examiner, Mack, II et al. provides description in column 9 of a hinge 1102 provided for storage purposes in non-use applications of the folding headset and for which does not appear to provide pivotal connection of any telephone control. The Examiner asserts that the Poon reference teaches a rotational connection and a C-shaped body (30) that provides 180 degree vertical and horizontal rotation of the housing 12.

However, a *prima facie* showing of the art teaching or suggesting has not been made as to the claimed recitation of a telephone control pivotally connected as recited in claim 1. Further, the claim limitation of a dial pad pivotally connected as recited in claim 35 has not been taught or suggested. Neither reference identifies a telephone control or a dial pad having the pivotally connected aspects of some embodiments of the present invention and as claimed. The Examiner appears to make the assumption that folding headbands and an earpiece are proper teachings of a telephone control or a dial pad, or even of the pivotal connection features of the present invention. Further, as to claim 35, no teaching has been suggested by the examiner of the recitation of configuration to provide hand-held configuration of the cordless telephone headset. The limitations of method claims 37 and 63, furthermore, have also likewise not been established under the Examiner's *prima facie* burden, such as the limitations of configuring a telephone control of the cordless telephone headset system to a user configuration.

As the Examiner has not made a *prima facie* showing of all of the claimed elements of the independent claims, specifically as identifying the teaching or suggestion of the above-described claim recitations in the prior art or through official notice, no further argument need be made as to the non-obviousness of the claimed invention. Furthermore, any further argument presented under these rejections and prior art cannot be made final until a *prima facie* argument for obviousness has been established by the Examiner.

Alternatively, should a *prima facie* case of obviousness be presented at a later time, it is presently asserted that the cited references of Mach, II et al. and Poon, and further the additionally cited patents, separately or in combination, do not make obvious at least the features of the invention as recited in the claims 1, 35, 37, and 63.

As the Examiner is well aware, the basic requirements of a *prima facie* case of obviousness are the establishment of the suggestion or motivation to modify the cited references, a reasonable expectation of success, and all claim limitations must be taught or suggested. *See, for example*, MPEP section 2143 et seq.

No motivation to combine the references, and at the time the invention was made, has been established by the Examiner with respect to the claimed recitations of claims 1, 35, 37, and 63. The Mach, II et al. and Poon references do not suggest the desirability of the claimed invention. Mach, II et al. merely discloses hinged configurations of the headband for storage purposes, while Poon discloses rotation of body (30) to provide left or right configurations for user's head. Neither suggest telephone control or dial pad features pivotally connected to a distal end of the headband, and as recited in the claims. Furthermore, neither suggest dial pad features configured to provide a hand-held configuration of a cordless telephone headset, and as recited in the claims. Even if it were assumed that the art cited taught all of the claim limitations, the motivation to combine the references and the desirability of the combination is not suggested by the prior art. *See* MPEP 2143.01.

Further with respect to the lack of establishing a *prima facie* case of obviousness, and although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). No suggestion is presented in Mach, II et al. or Poon that would suggest providing pivotal connection of telephone control or dial pad, and as recited in the claims. Connection in Poon is provided for operable head configuration, while hinged configuration in Mach, II et al. is provided for storage purposes. Further, No suggestion is presented in Mach, II et al. or Poon that would suggest hand held configuration, and as recited in the claims. Configurations in Mach, II et al. are directed to head operation or storage while Poon teaches head operation and additionally inward earpiece/receiver configurations.

The Examiner is also respectfully requested to consider the invention as a whole in determining the differences between the prior art and the claims, as described and mandated in MPEP 2141.02. The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed Cir. 1983). The Court in the cited case identified that where prior art may have perceived a need for certain functionality, the inventor eliminated the need via the

invention. *See case summary* MPEP 2141.02. “Because the insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art. *Stratoflex, Inc.* at 785.

The present invention provides, in some embodiments, for telephone control and dial pad pivotally connected to a distal end of a headband, and as recited in the claims. The present invention also provides configuration to provide a hand-held configuration of the cordless telephone handset. Although folding for storage and rotation for head configuration, and adjustable configuration generally, may have been a perceived need, the Mach II, et al. and Poon references do not show an understanding or expectation of pivotal connection of telephone control, or dial pad, and as claimed, as the present invention provides. Given non-hindsight understanding of the complexity of telephone control at the time of the invention, such functionality may have been contrary to understandings and expectations of art and those in the field. Furthermore, although headset operation may have been perceived, the Mach II, et al. and Poon references do not show an understanding or expectation of hand-held configuration, and as recited in the claims.

Furthermore, it is urged that the cited references do not disclose or suggest the invention as claimed in the dependent claims, and that dependent claims are novel and nonobvious as to the applied references. As the Examiner is also likely aware, if an independent claim is novel and nonobvious, the claims depending from the independent claims are also nonobvious. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). It is urged, therefore, that the dependent claims are novel and nonobvious as to the applied references at least as being dependent from the independent claims, respectively, as presented above, and further in view of the additionally recited limitations. However, as the independent claims are novel and nonobvious as to the applied references cited in the outstanding Office Action for at least the reasons provided above, accordingly, the Applicant respectfully requests the allowance of the independent and dependent claims.

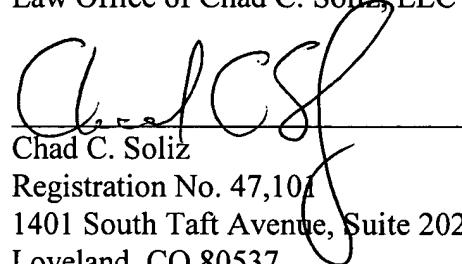
## CONCLUSION

Claims 1-64 are pending and claims 35 and 58 have been amended. In light of the above amendment and remarks, the Examiner's early reconsideration is earnestly requested.

If any outstanding issues remain with respect to this present amendment and request for reconsideration, the Examiner is respectfully requested to contact the undersigned attorney of record at his earliest convenience to initiate the resolution of any remaining concerns.

Dated this 26 day of October, 2004.

Respectfully submitted,  
Law Office of Chad C. Soliz, LLC

  
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